

REMARKS

This responds to office action dated May 12, 2009. A three-month petition for extension of time to reply and corresponding fee is included herein. Claims 5, 10-12, and 14 have been amended. Claim 14 has been amended to correct a minor typographical error. No new matter has been added; as a result, claims 5 and 10-14 are pending in the present application.

Applicants respectful request reconsideration in view of the points set forth below. Notwithstanding any claim amendments of the present Amendment or those Amendments that may be made later during prosecution, the Applicants' intent is to encompass equivalents of all claim elements. Reconsideration in view of the foregoing amendments and the following remarks is respectfully requested.

The Applicants reserve all applicable rights not asserted in or with this response, including, for example, the right to rebut tacit and explicit characterizations of one or more cited references, the right to rebut asserted combinations and motives for combinations, and the right to swear behind one or more cited references. The Applicants make no admissions regarding the status of any art of record as prior art.

35 USC §101 Rejection of the Claims

Claims 5 and 10-14 were rejected under 35 U.S.C 101 by the Examiner, as the Examiner stated that the claimed invention is directed to non-statutory subject matter.

The Examiner further stated claims 5 and 10-14 are non-statutory since they may be performed within the human mind.

Applicants respectfully submit that claims 5 and 10-12 have been amended to overcome the rejection. Each of the claims 5 and 10-12, as amended, are tied to a computer system. (See, for example, FIG. 1 of the application and the description corresponding to the FIG. 1). The Applicants therefore respectfully request withdrawal of the rejection of independent claims 5, 10, and 12, as well as all claims dependent thereon, under 35 U.S.C. 101.

35 USC §102 Rejection of the Claims

Claims 5 and 10-14 were rejected under 35 U.S.C 102 (e) as being anticipated by US Patent Application Publication No. 2002/0004775 (hereinafter, "Kossovsky"). Applicants respectfully traverse the rejection. The Applicants respectfully submit that independent claims 5, 10, and 12 are not anticipated by Kossovsky. A *prima facie* case of anticipation under 35 U.S.C. § 102 requires a showing that each limitation of a claim is found in a single reference, practice or device. (See *In re Donohue*, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985)).

The Applicants respectfully submit that independent claim 5 recites a method for facilitating transfer of an interest in an intellectual property asset via global computer network. The method includes formulation a proposed transfer of an interest in an intellectual property asset based on input submitted by a network user, presenting one

or more terms of said for the proposed transfer, permitting the network user to select one or more terms of said interest for the proposed transfer, permitting the network user to select one or more of the terms of said interest, limiting bidders via an access profile, defining the proposed transfer based at least part on the terms selected by the user, and posting the proposed transfer on a network resource residing on the global computer network.

Additionally, independent claim 10 recites a method for facilitating transfer of interests in intellectual property assets via a global computer network. The method includes auctioning an interest in an intellectual property asset via a network resource residing on the global computer network, wherein auctioning an interest includes listing, as part of an auction process, an asset identifier corresponding to the asset and terms of transfer of the interest in the intellectual property asset. The method further includes limiting access to the asset identifier and the terms of transfer as a function of an access profile associated with each network user, permitting the network user to select one or more terms of said interest, gathering bids from network users, and automatically adjusting the terms of transfer in the event no sufficient bids are gathered within a predetermined period of time.

The Applicants further submits that, independent claim 12 recites a method for auctioning an interest in an intellectual property asset via a global computer network. The method includes offering the interest in the intellectual property asset via a network resource residing on the global computer network, wherein the interest in the intellectual

property asset is defined by a proposed transfer agreement and a profile of users granted access to the proposed transfer agreement. The method further includes permitting the network user to select one or more terms of said interest, collecting bids from network users meeting the profile of users granted access to the proposed transfer agreement, and accepting one of said bids.

With respect to the independent claim 1, the Examiner stated that Kossovsky discloses the method for facilitating transfer of an interest in an intellectual property asset. Kossovsky discloses an online patent and license exchange, which enables potential licensors and licensees of patents and other intellectual property rights to efficiently and reliably transact IP license or assignment agreements. (See, Kossovsky, Abstract). The Examiner further stated that Kossovsky discloses *presenting one or more terms of said interest for the proposed transfer and permitting the network user to select one or more of the terms of said interest* (See Kossovsky , paragraphs 0043-0044 and figures 5A-5C, and 7A).

The Applicants respectfully submit that as pointed out in the previous response, Kossovsky is not a proper prior art as the filing date of Kossovsky (April 20, 2001) is after the Applicants' priority date (July 01, 1999). The Applicants further submit that the Provisional Kossovsky Application Serial No. 60/124,847 (hereinafter, "Kossovsky-provisional") filed March 17, 1999 fails to teach, suggest, or mention *presenting one or more terms of said interest for the proposed transfer and permitting the network user to select one or more of the terms of said interest*. Kossovsky-provisional describes "six

integrated functions of the invention" (see Kossovsky-provisional, page 4). The first is a database, the second is a sales mechanism for bidding a price for intellectual property, the third is to help the seller price the IP, the fourth is insurance, the fifth is document management and escrow, and the sixth is tracking funds paid for the IP. In each of these "six integrated functions", a user is not presented with one or more terms for a proposed transfer or bidding process. Additionally, the user is not provided with permission or an option of selecting terms based on which an IP is owned/purchased/transferred.

Moreover, the Applicants respectfully submit that Kossovsky-provisional is non-enabling. In Kossovsky-provisional, for each of the "six integrated functions", mere summary statements have been made regarding these integrated functions and details regarding how these integrated functions are build or how they work are not disclosed. For the sale mechanism, Kossovsky-provisional simply discloses an outline of the bidding process and does not provide details as to how the bidding process will be conducted. Similarly, for helping the seller price the IP, Kossovsky-provisional simply discloses some models that would be used to help the seller price the IP. However, Kossovsky-provisional fails to disclose the details regarding the methods implemented on these models to price the IP. For tracking funds paid for IP, Kossovsky-provisional merely mentions that funds exchanged as per payment requirements and terms of sales are tracked. However, Kossovsky-provisional fails to disclose the method that is used to track these funds. Similarly, for other integrated functions, mere summary statements

are mentioned in Kossovsky-provisional and the method used to implement them is not disclosed.

Further, with respect to independent claims 10 and 12, Kossovsky-provisional fails to teach, suggest, or mention *permitting the network user to select one or more terms of said interest*. Additionally, with respect to independent claim 10, Kossovsky-provisional fails to teach, suggest, or mention *automatically adjusting the terms of transfer in the event no sufficient bids are gathered within a predetermined period of time*. Kossovsky-provisional discloses a mechanism of receiving bids (mentioned in the second integrated function), in which, buyers can bid until asking price for an intellectual property is satisfied, the time-delimited auction market closes, or a bid is accepted. (See, Kossovsky-provisional, Page 5, Lines 4-6). Kossovsky-provisional nowhere mentions that if sufficient bid are not received within a time period, terms of transfer of the intellectual property are adjusted to facilitate the bidding process. Moreover, Kossovsky-provisional fails to teach, suggest, or mention automatic adjustment of terms of transfer of an intellectual property.

Based on the above discussion, a *prima facie* case of anticipation of the independent claim 5, 10, and 12 is not supported. Claims 11, 13, and 14 depend directly or indirectly from independent claims 5 and 12. Accordingly, the Applicants submit that claims 11, 13, and 14 are allowable by virtue of their dependency from an allowable base claim. The Applicants also submit that the dependent claims are further allowable by virtue of the subject matter they separately recite. Thus, it is respectfully requested

that the rejections of the independent claims 5, 10, and 12 and claims depending therefrom under 35 U.S.C. 102(e) be withdrawn.

Conclusion

Applicant respectfully submits that the claims 5 and 10-14 are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney, Ken Sheets, at (703) 236-2994 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-2646.

Respectfully submitted,

KENT J. SIEFFERT et al.

By their Representatives,

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Date November 12, 2009

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